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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 RECORD OF ORAL HEARING

2
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES

8
9
10 *Ex Parte* SHUNTARO ARATANI, YOSHIKAZU SHIBAMIYA,
11 SHIGEKI MORI, KATSUHIRO MIYAMOTO, and
12 TOMOYUKI OHNO

13
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15 Appeal 2009-003776
16 Application 09/987,569
17 Technology Center 2600

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20 Oral Hearing Held: September 22, 2009

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23 Before ROBERT E. NAPPI, MARC S. HOFF, and THOMAS S. HAHN,
24 *Administrative Patent Judges.*

25
26 ON BEHALF OF THE APPELLANTS:

27
28 JUSTIN J. OLIVER, ESQUIRE
29 FITZPATRICK CELLA HARPER & SCINTO
30 1290 Avenue of the Americas
31 NEW YORK NY 10104-3800

32
33 The above-entitled matter came on for hearing Tuesday,
34 September 22, 2009, commencing at 9:50 a.m., at the U.S. Patent and
35 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Cynthia
36 Sydnor-Thomas, Notary Public.

P R O C E E D I N G S

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THE USHER: Calendar No. 73. Mr. Oliver?

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JUDGE NAPPI: Good morning, Mr. Oliver.

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MR. OLIVER: Good morning.

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JUDGE NAPPI: If you have a business card that you could give the stenographer so she gets your spelling of your name proper.

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MR. OLIVER: Sure.

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JUDGE NAPPI: You have 20 minutes. You can begin as soon as you're ready.

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THE REPORTER: Thank you.

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MR. OLIVER: Good morning. Applicants are appealing the rejection of Claims 46 through 61 set forth in the Office Action of September 13, 2007. Specifically, that Office Action sets forth a rejection based on a combination of two references, the first being Ihara and the second one being Valdez. Also while not specifically stated so in the summary of the rejection, as discussed in the Office Action, the basis for the rejection also relies to citation on the Applicants' own specification -- for the obviousness argument.

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Basically to remedy deficiencies in the combination of Ihara and Valdez, the Office Action cites to not only the background of the invention specification but to Applicants' own specific embodiments --to the preferred embodiments section. In fact, the majority of the sections of the specifications cited to in the Office Action rely on the Applicants' own invention itself to establish obviousness. Consequently, as a basis for appeal, Applicants are submitting that Ihara and Valdez taken on their own do not disclose certain features of the invention and that their reliance on the

1 Applicants' own preferred embodiments is improper to remedy these
2 deficiencies.

3 There are two independent claims on appeal, Independent Claims 46
4 and 51. Forty-six is directed to a television signal receiving apparatus, and
5 51 is directed to a television signal receiving method. Both independent
6 claims recite similar features. I'll discuss the invention generally with
7 respect to the method steps. All the argument applies equally to both
8 independent claims.

9 As a bit of background, the invention is generally directed to the area
10 of printing data which is received in a TV broadcast to a set-top or a TV
11 signal receiving box such as a set-top box that you get in a cable or TV
12 system or a satellite TV system. More specifically, the invention is directed
13 to controlling a printer by acquiring status information from the printer and
14 displaying that status information using information provided in the markup
15 language sent in the TV broadcast. It is these features of the invention
16 which Applicants submit are not taught by either Ihara or Valdez.

17 As a little bit of background, a conventional system such as a PC
18 might have an operating system which provides the necessary functionality
19 to communicate with the printer to obtain the status of the printer. For
20 instance, is the printer jammed; does the printer have proper paper; so on
21 and so forth. The operating system provides this functionality based on the
22 software stored in that system. To the extent it doesn't, it can always be
23 uploaded easily by a CD-Rom or other system.

24 In TV signal receiving apparatuses in the conventional art, basically
25 they were -- there were some discussions of printing apparatuses being
26 hooked up to such devices. However, they were traditionally dedicated

1 terminals which provided the necessary functionality for providing printing
2 required and so forth. What the present invention does is deal with a TV
3 signal receiving apparatus which may not have the necessary functionality
4 for querying a printer with respect to its status and displaying that
5 information, and it also may not be easy to upload such information into a
6 set-top box. Consequently, the present invention is directed at remedying
7 this problem, and the independent claims recite features which do remedy
8 these deficiencies in the art.

9 In particular, the independent claims generally recite receiving a TV
10 signal having content data. TV broadcasts may have content data such as
11 video, audio, documentary which might describe a program. In the present
12 invention, the document data is provided in markup language. The markup
13 language -- the markup language could be HTML such as that used in web-
14 browsing systems. Even more specifically, each of the independent claims
15 recites that document data provided and broadcast and in a markup language
16 included both a script for acquiring status of the printer and status display
17 information. The invention further includes that the script is executed and
18 status information of the printer is acquired, and that status display
19 information is displayed to a user to indicate the status of the printer. These
20 features provided in the markup language are simply not disclosed in
21 references, these features being --

22 JUDGE HAHN: Counsel?

23 MR. OLIVER: Yes.

24 JUDGE HAHN: In reviewing the record here -- this is essential -- the
25 document data that you're making reference to that's in the -- that's included

1 in the broadcast signal, and as I understand from Claim 46 extracted by the
2 extracting -- that document data is not your invention, is it?

3 MR. OLIVER: The document data itself is not the invention that the
4 markup language has --

5 JUDGE HAHN: It's the use of that document data.

6 MR. OLIVER: In a certain, yeah, in a certain batch, correct. And it's
7 specifically that the document data, which in this case is markup language,
8 has specific features, those features being a script for querying a printer to
9 acquire the status information and then also the display information so that
10 that acquired status can be displayed to a user. And it is those features
11 which are deficient in the prior art.

12 The Office Action as much as acknowledges this. Specifically, Ihara
13 is used to show that a TV broadcast apparatus and a printer can be hooked
14 together. The Office Action acknowledges that Ihara does not show this
15 display information or the script for acquiring the status of a printer. There's
16 reliance on the second reference, Valdez, to show that feature. Valdez is
17 cited in the Office Action as providing a markup language in a TV
18 broadcast. Now if the claims are directed alone to providing markup
19 language in a TV broadcast, this rejection might be sound. However, that's
20 not the only features recited in the independent claims. The independent
21 claims go on to state that markup language has this specific functionality
22 including the script for acquiring the status of a printer as well as the display
23 information which is displayed to the user based on the acquired status.
24 Valdez fails to show this.

25 We believe the Office Action as much as acknowledges that, because
26 the Office Action goes on to state that in relying on that portion of the

1 independent claims, namely the script and the display information, to the
2 extent it's not showing Valdez, the Office Action cites to the Applicants'
3 own specification, the majority of those paragraphs of which are the
4 preferred embodiments of the invention. So in fact, what the Office Action
5 has done has cited to the invention as it's showing that the invention is
6 obvious --

7 JUDGE HOFF: Is the Examiner actually citing to the IEEE standard?

8 MR. OLIVER: The Examiner does cite to the IEEE standard. That's
9 the -- just a standard for communication. The Examiner specifically states
10 regarding the new limitation of document dating including a script for
11 acquiring status information of a printer and status display information
12 corresponding to the acquired status information, it is noted that the
13 Appellants' own specification discloses that by incorporating a browser into
14 a television, a user may receive broadcast markup language and perform the
15 claimed operations. The Examiner there cites to the actual paragraphs of the
16 specification, in particular, paragraphs in the preferred embodiments. The
17 Examiner doesn't find a basis as to why the standard for communication
18 alone would provide these necessary features of the invention, namely the
19 script being provided in the markup language that's broadcast and the
20 displayed invention. The standard is the standard for communication.
21 Whether or not what is being communicated and the manner of what is being
22 communicated is not taught by the standard. It also doesn't appear that the
23 Examiner even obtained the standard. The Examiner seemed to just note
24 that one reference uses the standard, and the specification talks about the
25 standard and makes the leap from there. It's the Appellants' position that

1 that alone does not teach the specific features of the invention, namely the
2 script and status display information.

3 In detail, what's basically going on here, there are two references
4 being combined, Ihara and Valdez. Valdez simply states that a TV
5 broadcast may include markup language. However, going on from there is
6 where the Office Action goes off under the use of the Applicants'
7 specification. There are specific features that are acquired in that markup
8 language in the invention recited in both of the independent Claims 46 and
9 51. That includes the acquisition script which requires printer information
10 and the display information being displayed once the printer status has been
11 acquired. Those features are not disclosed in Valdez, and to the extent that
12 the Office Action suggests those features are known in the art, it's based on
13 the Applicants' preferred embodiments and that's simply -- at the very least
14 that's hindsight which is improper. And even more so, it seems that the
15 Examiner is submitting that the Applicants' preferred embodiments are a
16 prior art which is not the case, because there's no admission that the
17 Applicants' own preferred embodiments of the invention are prior art to the
18 invention itself.

19 JUDGE HAHN: Counselor, one of the paragraphs that the Examiner
20 cited was 57 from your specification.

21 MR. OLIVER: Yes.

22 JUDGE HAHN: Would you look at that paragraph, please, because it
23 does appear to be a statement of what is in the prior art and no more than
24 that.

25 MR. OLIVER: 57 does talk about a standard and what is -- what type
26 of information is applied -- is available in that standard, and it does discuss

1 script information. The invention is not directed at what is or may be
2 included in a markup language. The question here is providing in a markup
3 language a script that performs a certain function provided -- and that script
4 being provided in a TV broadcast. Here the script performs a function of
5 acquiring status information from the printer and then also the second
6 displaying that information. That scripts may be used in the prior art still
7 doesn't get to the invention as recited in the independent claims which are a
8 script for performing a certain function and display information that is
9 displayed based on the acquisition of the printer information from the script.

10 Now I grant you that 57 does talk about the standard and does talk
11 about script information, but that's still a far cry from the specific use of the
12 script in independent Claims 46 and 51.

13 JUDGE HAHN: In other words, you -- and you're saying your
14 Appellants' implementation of that script is the invention that's being
15 claimed?

16 MR. OLIVER: Yes, the actual type of script that's being used in the
17 markup language, what it performs, what it does and its implementation. It's
18 not the implementation alone. There's no -- just because there's script
19 information here doesn't mean that a script information provided in markup
20 language is known to do what is recited in the independent claims.

21 Secondly, you are correct that the implementation also is not made
22 obvious by the existence of the standard alone that shows script information
23 was known in the art.

24 If there are not any other questions, Appellants again submit that the
25 specifics of the invention recited in independent claims here, namely the
26 acquisition of printer information using a script and markup language, and

1 the display of the same is not shown in the two references cited by the
2 Examiner, and furthermore, the reliance on the preferred embodiments of the
3 invention is an improper way to cure these deficiencies. Therefore, the
4 Appellants request that the rejection be reversed.

5 JUDGE NAPPI: Any questions?

6 JUDGE HOFF: No.

7 JUDGE NAPPI: Tom?

8 JUDGE HAHN: No.

9 JUDGE NAPPI: Thank you very much for your time.

10 MR. OLIVER: Thank you.

11 (Whereupon, the proceedings, at 10:03 a.m., were concluded.)